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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,081	01/22/2002	Eiichiro Kitagawa	03560.002981	3430
5514	7590	12/23/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			PHAM, CHRYSTINE	
			ART UNIT	PAPER NUMBER
			2122	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/051,081	KITAGAWA, EIICHIRO	
	Examiner Chrystine Pham	Art Unit 2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 January 2002.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
 4a) Of the above claim(s) 21 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-20,22 and 23 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) 21 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 22 January 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1.) Certified copies of the priority documents have been received.
 2.) Certified copies of the priority documents have been received in Application No. _____.
 3.) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9 April 2002</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to Application 10/051081 filed on January 22nd 2002. Claims 1-20, 22, and 23 are presented for examination.

Priority

2. Acknowledgment is made of Applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in Application No. 10/051081, filed on January 22nd 2002. Priority date of January 23rd 2001 is hereby granted.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I.	Claims 1-20, 22, and 23, drawn to network software download/installation, classified in class 717, subclasses 177, 178.
Group II.	Claim 21, drawn to business practice, classified in class 705, subclasses 50+.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination of Group I as claimed does not require the particulars of the subcombination of Group II as claimed because these inventions have acquired a separate status in the art as shown by their different classification. The subcombination Group II has separate utility such as business practice (distribution or sale of software products).

Because these inventions are distinct for the reasons given above, restriction for examination purposes as indicated is proper.

During a telephone conversation with Leonard P. Diana (Reg. No. 29296) on December 6th 2004, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-20, 22, and 23. Affirmation of this election has been made by applicant and received by The Office in Fax No. 1212 218 4551. Claim 21 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 3-6, 14-16, 22, 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Gazdik (US 6324691), hereinafter, *Gazdik*.

Claim 3

Gazdik teaches an information processing device and method (e.g., see Abstract; see end user's machine, client machine col.2:25-33) comprising:

- *a communication unit adapted to communicate (i.e., communication step) with a server terminal on a network (e.g., see Internet download option col.3:30-37; see Internet, remote server col.4:14-25);*
- *a portable-information-storage-medium connection unit (i.e., connection step) to which a portable information storage medium (e.g., see removable disk, CD-ROM, DVD disk col.3:30-37) storing information (i.e., identification information of the software AND location information representing a location on the network at which the identified software is stored) on software (e.g., see original distribution media package, see Internet download*

option col.30-37; see software col.4:14-25; see access to Internet col.5:45-60) to be acquired via the network is connected (e.g., see remote server col.3:30-50);

- **an information transfer unit (i.e., information transfer step) adapted to download the software, represented by the software identification information, using the location information, from the server terminal into an internal storage medium by using said communication unit (e.g., see new distribution medium, downloaded col.3:55-60);**
- **a software storage unit adapted to store, in a software storage area of the internal storage medium, the software downloaded into the internal storage medium (e.g., see mass storage medium, new distribution medium col.3:49-67; see MASS STORAGE 16 FIG.1 & associated text);**
- **a software management unit (i.e., software management step) adapted to manage the software stored in the software storage area (e.g., see INSTALLER PROCESSING ENGINE 11 FIG.1 & associated text); and**
- **an external-storage-medium reading unit (i.e., external-storage-medium reading step) adapted to read predetermined information written in the portable information storage medium when the portable information storage medium is connected to said portable-information-storage-medium connecting unit (e.g., see removable disk, CD-ROM, DVD disk col.3:30-37).**

Claim 4

The rejection of base claim 3 is incorporated. Claim recites limitations, which have been addressed in claim 1, therefore, is rejected for the same reasons as cited in claim 1.

Claim 5

The rejection of base claim 4 is incorporated. Claim recites limitations, which have been addressed in claim 1, therefore, is rejected for the same reasons as cited in claim 1.

Claim 6

The rejection of base claim 3 is incorporated. *Gazdik* does not expressly disclose wherein said software management unit performs a software activating process for executing the software stored in the software storage area. However, this feature is deemed inherent in the teaching of *Gazdik* wherein software is downloaded and installed from a network server into an end-user's computer. It is inconceivable that the end-user's computer does not have the means (i.e., software management unit performing software activating process) for executing the software after it has taken all the necessary steps to download and install the software in the software storage area.

Claim 14

The rejection of base claim 4 is incorporated. *Gazdik* further teaches wherein, when software represented by the software identification information is not downloaded into the software storage area, said software management unit executes a process for downloading the software into the software storage area (e.g., see *new distribution media package, unknown, updated versions* col.3:30-60).

Claim 15

The rejection of base claim 14 is incorporated. Claim recites limitations, which have been addressed in claim 6, therefore, is rejected for the same reasons as cited in claim 6.

Claim 16

The rejection of base claim 4 is incorporated. *Gazdik* further teaches wherein:

- when software represented by the software identification information is downloaded into the software storage area, said software management unit performs a process for comparing a version of software stored in said server terminal and a version of software stored in the software storage area (e.g., col.3:44-49);
- said software management unit performs a process for initiating execution of the software in the software storage area when both versions match each other (e.g., see *current files* col.3:55-60); and

- o when the version of the software stored in the server terminal is newer than the version in the software storage area, said software management unit performs a process that, after downloading the software from the server terminal into the software storage area, initiates execution of the downloaded software (e.g., see *updated versions* col.3:55-60).

Claim 22

Claim recites an information processing method performed by the information processing device addressed in claim 1, therefore, is rejected for the same reasons as cited in claim 1.

Claim 23

Gazdik teaches computer-readable storage medium storing a program for controlling a computer to execute an information processing method as set forth in claim 22 (e.g., see *PROCESS CONTROL STATE FILE 12 FIG.1* & associated text; see *Pcommand 31 FIG.3* & associated text).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. Claims 1,2 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Gazdik* in view of *Carr et al.* (US 6788800), hereinafter, *Carr et al.*.

Claim 1

Gazdik teaches a portable information storage medium loadable into an information processing device connected to a network (see claim 3), the information processing device adapted to execute software

downloaded from the network (see claim 6), said portable information storage medium including a storage area for storing software information including:

- o identification information on the software (see claim 3);
- o location information representing a location on the network at which the software is stored (see claim 3).

Gazdik does not expressly disclose secret information on a user who uses the software.

However, *Carr et al.* teach a portable information storage medium including a storage area for storing software information including product code, serial number, and secret information on a user who uses the software (e.g., see *embedded security data* col.5:28-47; see *embedded data, key, CD, DVD, product identifier, serial number, password* col.6:8-23). *Gazdik* and *Carr et al.* are analogous art because they are both directed to a method of downloading software from network source (e.g., see *software product, installation, web server* col.5:1-10). It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to incorporate the teaching of *Carr et al.* into that of *Gazdik* for the inclusion of product code, serial number, and secret information. And the motivation for doing so would have been to facilitate automated authentication of BOTH the software product and the user of the software product to prevent illegal usage of the software by unauthorized users and to further detect counterfeit copies of the software product.

Claim 2

The rejection of base claim 1 is incorporated. Claim recites limitations, which have been addressed in claims 1 and 3, therefore, is rejected for the same reasons as cited in claims 1, and 3.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Gazdik* in view of *Shih et al.* (US 6405362), hereinafter, *Shih et al.*.

Claim 7

The rejection of base claim 3 is incorporated. *Gazdik* further teaches a deletion process for deleting the software stored in the software storage area (e.g., see *unexecuted()*, *uninstall* col.7:5-57). *Gazdik* does not expressly disclose wherein, when the portable information storage medium is disconnected from said portable-information-storage-medium connecting unit, said software management unit performs a deletion process for deleting the software stored in the software storage area. However, *Shih et al.* teach a system and method of detecting removal or disconnection of the portable information storage medium from the connecting unit (e.g., see *Compact Flash memory card, software, removed* col.3:5-20; see 28, 30, 29, 31 FIG.1 & associated text; see col.4:55-60) wherein when the portable information storage medium is disconnected from said portable-information-storage-medium connecting unit, said software management unit performs a deletion process for deleting the software stored in the software storage area (e.g., see *cleaning up, releasing resources* col.3:5-25; col.6:30-55; see *removal message, application* 220 col.7:19-30; col.7:60-67). *Gazdik* and *Shih et al.* are analogous art because they are both directed to software installation. It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to incorporate the teaching of *Shih et al.* into that of *Gazdik* for the inclusion of deletion process upon disconnection of portable storage medium. And the motivation for doing so would have been to reduce potential application or system crashes caused by referencing memory on the portable storage medium which has been disconnected and to further free up memory for use by other applications and programs.

8. Claims 8, 9, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Gazdik* in view of *Foster et al.* (US 6121967), hereinafter, *Foster et al.*.

Claim 8

The rejection of base claim 3 is incorporated. *Gazdik* does not expressly disclose wherein, when the portable information storage medium is disconnected from said portable-information-

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storage-medium connecting unit while the software stored in the software storage area is being executed, said software management unit performs a medium-unloading warning process, for warning a user by interrupting execution of the software stored in the software storage area, and a user-input accepting process, for activating a user-input accepting state after the medium-unloading warning process is performed. However, *Foster et al.* teach wherein, when the portable information storage medium (e.g., see *floppy disk*, *floppy drive* col.4:45-55; see *devices, media bays* col.5:1-10) is disconnected from said portable-information-storage-medium connecting unit while the software stored in the software storage area is being executed, said software management unit performs a medium-unloading warning process, for warning a user by interrupting execution of the software stored in the software storage area (e.g., see *halt processing*, *removed a "locked" media bay device* col.2:1:15), and a user-input accepting process (i.e., user selects termination or restarting execution of software), for activating a user-input accepting state after the medium-unloading warning process is performed (e.g., see *reinsertion* col.2:5-15; see 412 FIG.4 & associated text; col.8:60-col.9:25).

Claim 9

The rejection of base claim 8 is incorporated. *Foster et al.* further teach wherein, when the portable information storage medium is connected again after the medium-unloading warning process is performed, said software management unit performs an execution restarting process for restarting execution of the software (e.g., col.9:15-25).

Claim 17

The rejection of base claim 3 is incorporated. *Foster et al.* further teach wherein:

- when the software is terminated while the portable information storage medium is being loaded into said portable-information-storage-medium connecting unit, said software management unit displays, on a menu screen, an option for reactivating the software so that the software can be reactivated by input from a user (e.g., see 410, 412, 418 FIG.4 & associated text; see 114, 116 FIG.1B & associated text); and

- when the portable information storage medium is unloaded after the software is terminated (i.e., user selects termination of execution of the software in the user-input accepting state), said software management unit performs a process for deleting the option for reactivating the software (i.e., software management unit performs a process for terminating execution of the software) from the menu screen so that reactivation of the software cannot be performed in response to input from a user (e.g., col.2:5-15; see 412, 414, 416 FIG.4 & associated text; see 118 FIG.1B & associated text).

Claim 18

The rejection of base claim 8 is incorporated. Claim recites limitations, which have been addressed in claims 8, and 9, therefore, is rejected for the same reasons as cited in claims 8, and 9.

Claim 19

The rejection of base claim 8 is incorporated. Claim recites limitations, which have been addressed in claim 17, therefore, is rejected for the same reasons as cited in claim 17.

Claim 20

The rejection of base claim 3 is incorporated. *Gazdik* further teaches wherein, when the portable information storage medium is unloaded while the software is being executed, said software management unit continues execution of the software (e.g., col.7:44-50), and, when a user terminates execution of the software, said software management unit performs a process for deleting an option for reactivating the software from a menu screen, so that reactivation of the software cannot be performed in response to input from a user (see claim 17).

9. Claims 12, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Gazdik* in view of *Srinivasan* (US 6460076), hereinafter, *Srinivasan*.

Claim 12

The rejection of base claim 3 is incorporated. *Gazdik* further teaches wherein:

- o the internal storage medium includes a nonvolatile memory (i.e., internal storage) (e.g., see *mass storage device, component persistent data file* col.3:10-27; see *mass storage medium* col.3:49-55). *Gazdik* does not expressly disclose a volatile memory. However, this feature is deemed inherent in the teaching of *Gazdik* wherein the end-user computer downloads, and installs executable software programs/applications (e.g., see *executable* col.1:53-56). At the time of applicant's invention, it is well known in the art that volatile memory (i.e., RAM) can be read from and written to and is therefore used for storing application programs and data that can be manipulated and changed. Thus, volatile memory is utilized by the computer's CPU during program execution, and is inherent in the teaching of *Gazdik*. *Gazdik* does not expressly disclose said software management unit stores a device identification in the nonvolatile memory (i.e., internal storage). However, this feature is deemed inherent in the teaching of *Gazdik* because it is inconceivable that a computer operating system functions without maintaining the knowledge and information of the device or hardware (i.e., device identification) it is operating on. Furthermore, it is inconceivable that such device identification should be saved in (i.e., written to) a volatile memory where it can be lost due to system power outage as opposed to a nonvolatile memory where it can later be retrieved for processing during system re-booting. *Gazdik* further teaches after the portable information storage medium is loaded into said information processing device, said software management unit examines whether or not information are written in the portable information storage medium (e.g., see *comparing component files, original distribution media package* col.3:44-49). *Gazdik* does not expressly disclose storing user information in internal storage and

device identification and user information are written to the portable information storage medium. *Gazdik* does not expressly disclose when the device identification and the user information are not written, said software management unit writes the device identification and the user information into the portable information storage medium. However, *Srinivasan* teaches an apparatus and method providing for the downloading software from a network server to a user computer wherein **user information** is provided (e.g., see *authentication, verification* col.4:20-40) and **software** (i.e., data or information) is **recorded** (i.e., written to) in **portable media** (e.g., see Abstract; see *VERIFY THAT MEDIA RECORDER IS READY, DOWNLOAD FILE TO MEMORY IN USER INTERFACE, TRANSFER FILE TO MEDIA RECORDER FIG.3 & associated text; see network, downloadable software, portable media* col.1:60-col.2:36). *Gazdik* and *Srinivasan* are analogous art because they are both directed to method of downloading software from a network server (i.e., terminal). It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to incorporate the teaching of *Srinivasan* into that of *Gazdik* for the inclusion of storing user information in internal storage, and writing information (i.e., device identification and user information) to the portable storage medium. And the motivation for doing so would have been to provide portability or mobility for these information, enabling access to these information when the portable storage medium is loaded on and read by a different device for downloading software or replicating the information to other portable or non-portable storage media through use of the device.

Claim 13

The rejection of base claim 12 is incorporated. *Gazdik* further teaches **wherein, after the portable information storage medium is loaded into said information processing device, said software management unit examines whether or not the device identification and the user information are written in the portable information storage medium, and, when the device identification and the user information are written, and**

said software management unit finds, by comparing a device identification stored internally in said information processing device and the device identification written in the portable information storage medium, identity between both device identifications, said software management unit initiates accessing of the server terminal (e.g., see *comparing, copying* col.3:44-60).

10. Claims 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Gazdik* in view of *Foster et al.* further in view of *Shih et al.*.

Claim 10

The rejection of base claim 8 is incorporated. Claim recites limitations, which have been addressed in claims 7, and 8, therefore, is rejected for the same reasons as cited in claims 7, and 8.

Claim 11

The rejection of base claim 3 is incorporated. Claim recites limitations, which have been addressed in claims 7, and 20, therefore, is rejected for the same reasons as cited in claims 7, and 20.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
 - o Fite et al. (US 5930215)
 - o Slivka et al. (US 6256668)
 - o Larsson et al. (US 6226747)

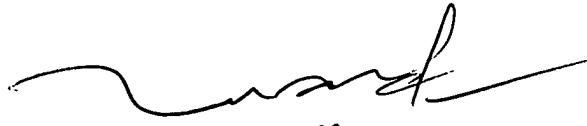
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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chrystine Pham whose telephone number is 571-212-3702. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q Dam can be reached on 571-272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 9, 2004



TUAN DAM
SUPERVISORY PATENT EXAMINER